

REMARKS

Claims 1, 4 have been corrected to change “then” to than, a typographical correction not narrowing the claims.

The term “co-planar” has been added to the specification and amended claims 1 and 7 to distinguish Herrera. This is not new matter because applicant’s Figures 1, 2, 4, 5, 6 clearly define two co-planar ovals, as presently claimed.

Herrera’s FIG’S. 13, 14 are described at page 5, paragraph 0071, 0072. His blades are “slightly twisted” and helix shaped to allow for his different blade crossings of plane 330..

As Examiner also notes, the first phase cutter is not disclosed by Herrera, but is known in the art (thin to thick flat blade). Examiner rejected claim 4 as obvious in view of Herrera, now previous claim 4 is a limitation in amended claim 1.

The further limitation of two co-planner oval blades sets the present invention into a new, useful, and non-obvious category. Fahra does not disclose two co-planar oval blades, he only discloses one oval. Hindsight is not permissible to pick and choose known aspects of prior art and reject the Applicant’s invention.

Applicant’s device is in production and for sale at local Wal-Mart® stores. It is in its early product life cycle.

LAW OF OBVIOUSNESS

It is well known that most inventions are composed of elements that *per se* are old and well known. That however, does not make an invention “obvious” under 35 U.S.C. 103. The Examiner’s attention is respectfully drawn to, for example, *ACS Hospital Systems, Inc. v. Montefiore Hospital et al.*, 732 F.2d 1572, 1577, 221 USPQ 929 (Fed. Cir. 1984), wherein the Court held that “[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed combination, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so.”

Also, as stated in *W.L. Gore & Associates, Inc. v. Garlock, Inc.* 721 F.2d 1540, 1553, 220 USPQ 303 (Fed. Cir. 1983):

To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

Finally, even if all the constituents of an invention may be old, if the result would not have been obvious at the time the invention was made to a person having ordinary skill in the art, then the result may be patentable. *Reiner v. I. Leon Co.*, 285 F.2d 501, 503-504, 128 USPQ 25, (2d Cir. 1960).

In order to determine the basis for the rejection, the Examiner must:

- 1). Determine the scope and contents of the prior art;
- 2). Ascertain the differences between the prior art and the claims in issue;
- 3). Resolve the level of ordinary skill in the pertinent art; and
- 4). Evaluate evidence of secondary considerations.

Other basic considerations include:

- 1). The claimed invention must be considered as a whole;
- 2). The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- 3). The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- 4). Reasonable expectation of success is the standard with which obviousness is determined.

Finally, to sustain a *prima facie* case of obviousness:

- 1). There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
- 2). There must be a reasonable expectation of success; and
- 3). The prior art reference must teach or suggest all the claim limitations.

The Examiner fails to meet the requirements to sustain an obviousness rejection based on these references.

LAW OF ANTICIPATION

Section 102 (e) provides:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent....

A claim is anticipated only if each and every element as set forth in the claim is found either expressly or inherently described, in a single prior art reference. See: *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed Cir. 1987), *Structural Rubber Prods. CO. v. Park Rubber Co.*, 749 F.2d 707, 715, 223 USPQ 1264, 1270, (Fed. Cir. 1984), *Connell*, 722 F.2d at 1548, 220 USPQ at 198; *Kalman v. Kimberly-Clark Corp.*, 713 F.2d 760, 771, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026, 104 S. Ct. 1284, 79 L. Ed.2d 687 (1984).

Applicant respectfully requests the Examiner to pass Notice of allowances.

Respectfully submitted,



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